

Docket No. 244818US0CIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: :

Veronique FERRARI, et al. : EXAMINER: J. VENKAT

SERIAL NO.: 10/733,467 :

FILED: DECEMBER 12, 2003 : GROUP ART UNIT: 1619

FOR: COSMETIC COMPOSITION CONTAINING
A POLYORGANOSILOXANE POLYMER

APPEAL BRIEF

Appellants submit this brief in response to the Rejection dated December 30, 2009.

REAL PARTY OF INTEREST

The real party in interest herein is L'Oréal S.A. of Paris, France.

RELATED APPEALS AND INTERFERENCES

To the best of Appellants' knowledge, there are no appeals or interferences which will directly affect or be directly affected by, or have a bearing on, the Board's decision in this appeal.

STATUS OF CLAIMS

Claims 74, 75, 78, 79, 81, 83, 85, 87, 88, 90, 91, 93, 94, 96, 98, 99, 102, 103, 105, 107, 109, 111, 112, 114, 115, 117, 118, 120, 122, 123, 126, 127, 129, 131, 133, 135, 136, 138, 139, 141, 142, 144 and 146-166 are currently pending.

Claims 1-73, 76-77, 80, 82, 84, 86, 89, 92, 95, 97, 100, 101, 104, 106, 108, 110, 113, 116, 119, 121, 124, 125, 128, 130, 132, 134, 137, 140, 143, and 145 have been canceled.

STATUS OF AMENDMENTS

All amendments have been entered and considered. There are no outstanding amendments in this case.

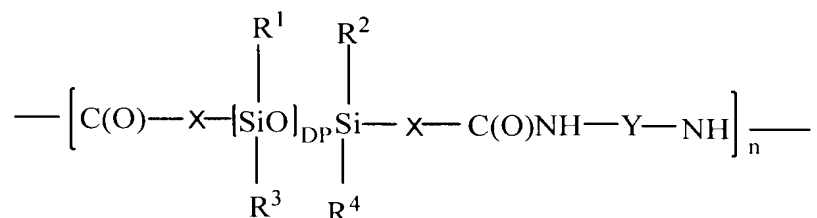
SUMMARY OF CLAIMED SUBJECT MATTER

Claim 74: The invention relates to methods of applying a transfer-resistant composition to a keratin material (Specification at page 5, pars. [0015]-[0017]) comprising applying to the keratin material a liquid, (Specification at page 11, par. [0032]) transfer-resistant composition comprising at least one silicone-polyamide copolymer, (Specification at page 20, par. [0049])

at least one silicone resin film forming agent, (Specification at page 51, par. [00143])

and at least one coloring agent, (Specification at page 86, par. [0313])

wherein the silicone-polyamide copolymer comprises multiples of a unit represented by the following formula (A):



where: (a) DP is between 1 and 700; (b) n is a number selected from the group consisting of 1-500; (c) X is a linear or branched chain alkylene having 1-30 carbons; (d) Y is selected from the group consisting of linear or branched chain alkenes having 1-40 carbons; (e) R¹, R², R³ and R⁴ are the same or different and may be selected from the group consisting of methyl, ethyl, propyl, isopropyl, a siloxane chain, and phenyl. (Specification at pages 22-24, pars. [0052] and [0055]-[0057])

GROUND TO BE REVIEWED ON APPEAL

1. Whether claims 74, 75, 78, 79, 81, 83, 85, 87, 88, 90, 91, 93, 94, 96, 98, 99, 102, 103, 105, 107, 109, 111, 112, 114, 115, 117, 118, 120, 122, 123, 126, 127, 129, 131, 133, 135, 136, 138, 139, 141, 142, 144 and 146-160 are obvious under 35 U.S.C. § 103 over U.S. patent 5,837,223 (“Barone”) and PCT patent application publication no. WO 03/013447 (“PCT ‘447”).

2. Whether claims 74, 75, 78, 79, 81, 83, 85, 87, 88, 90, 91, 93, 94, 96, 98, 99, 102, 103, 105, 107, 109, 111, 112, 114, 115, 117, 118, 120, 122, 123, 126, 127, 129, 131, 133, 135, 136, 138, 139, 141, 142, 144 and 146-153 are obvious under the judicially created doctrine of double patenting over 35 U.S.C. § 103 over claims 1-25 in U.S. patent 6,958,155 in view of Barone.

ARGUMENT

- I. **Claims 74, 75, 78, 79, 81, 83, 85, 87, 88, 90, 91, 93, 94, 96, 98, 99, 102, 103, 105, 107, 109, 111, 112, 114, 115, 117, 118, 120, 122, 123, 126, 127, 129, 131, 133, 135, 136, 138, 139, 141, 142, 144 and 146-153 are not obvious under the judicially created doctrine of double patenting over 35 U.S.C. § 103 over claims 1-25 in U.S. patent 6,958,155 in view of Barone**

The Terminal Disclaimer submitted November 30, 2007, included disclaimer over U.S. Patent Application Serial No. 10/166,762. The '762 application matured into U.S. Patent 6,958,155. Thus, the present application has already been terminally disclaimed over the '155 patent. Accordingly, applicants respectfully submit that the double patenting rejection should be reversed.

II. Claims 74, 75, 78, 79, 81, 83, 85, 87, 88, 90, 91, 93, 94, 96, 98, 99, 102, 103, 105, 107, 109, 111, 112, 114, 115, 117, 118, 120, 122, 123, 126, 127, 129, 131, 133, 135, 136, 138, 139, 141, 142, 144 and 146-160 are obvious under 35 U.S.C. § 103 over Barone and PCT '447

The invention methods relate to methods of applying a transfer-resistant composition to a keratin material. The invention methods require the presence of both a silicone-polyamide copolymer and a silicone film forming resin (particularly MQ resin or trimethylsiloxysilicate) in a liquid composition.

The Examiner rejected the pending claims under 35 U.S.C. § 103 as obvious over Barone in view of PCT '447. The applied art does not teach or suggest the invention methods for at least the following reasons.

First, PCT '447 is not prior art. PCT '447 was filed August 6, 2002. In contrast, the present application is a continuation-in-part application claiming priority from several applications including eight separate applications filed in June 2002. Thus, PCT '447 is not prior art at least with respect to the subject matter disclosed in the eight priority applications filed in June 2002. At least one June 2002 parent application of the present application teaches the required silicone resin/silicone-polyamide copolymer combination. (U.S. patent application serial no. 10/166,755). Accordingly, PCT '447

does not constitute relevant prior art to the invention methods. Because PCT '447 is not prior art, the obviousness rejection must fail.

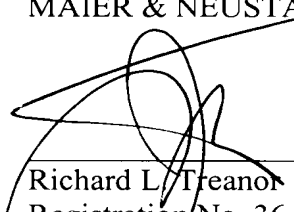
Second, the applied art does not suggest the claimed liquid compositions. Barone discloses stick compositions (see, col. 1, line 59; abstract). Thus, Barone teaches away from liquid compositions. Moreover, one of ordinary skill in the art would not have been motivated to modify Barone's compositions to make them liquid in direct contravention to Barone's teachings. PCT '447's disclosure does not change this fact. Stated another way, one of ordinary skill in the art, following Barone, would prepare a solid composition, not a liquid composition, regardless of PCT '447's disclosure. Thus, the applied art would not lead one of ordinary skill in the art to the claimed compositions or methods.

CONCLUSION

In view of the above remarks and reasons explaining the patentable distinctness of the presently appealed claims over the applied prior art, Appellants request that the Examiner's rejections all be REVERSED.

Respectfully submitted,

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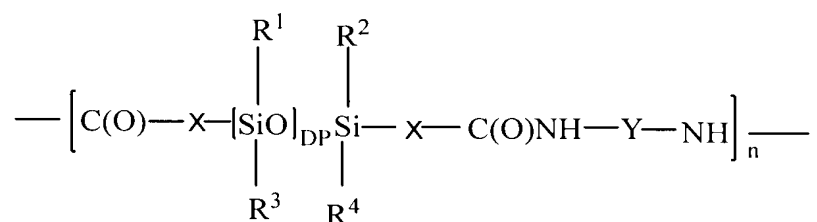
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APPENDIX I (CLAIMS)

1-73. (Canceled).

74. (Previously Presented): A method of applying a transfer-resistant composition to a keratin material comprising applying to the keratin material a liquid, transfer-resistant composition comprising at least one silicone-polyamide copolymer, at least one silicone resin film forming agent, and at least one coloring agent, wherein the silicone-polyamide copolymer comprises multiples of a unit represented by the following formula (A):



where: (a) DP is between 1 and 700; (b) n is a number selected from the group consisting of 1-500; (c) X is a linear or branched chain alkylene having 1-30 carbons; (d) Y is selected from the group consisting of linear or branched chain alkylenes having 1-40 carbons; (d) R¹, R², R³ and R⁴ are the same or different and may be selected from the group consisting of methyl, ethyl, propyl, isopropyl, a siloxane chain, and phenyl.

75. (Previously Preseted): The method of claim 74, wherein the composition further comprises at least one volatile oil.

76-77. (Canceled).

78. (Previously Presented): The method of claim 74, wherein the film former is selected from the group consisting of polymethylsilsesquioxane, trimethylsiloxysilicate, and mixtures thereof.

79. (Previously Presented): The method of claim 74, wherein the film former is trimethylsiloxysilicate.

80. (Canceled).

81. (Previously Presented): The method of claim 75, wherein the composition comprises at least one volatile oil which is a volatile hydrocarbon oil.

82. (Canceled).

83. (Previously Presented): The method of claim 81, wherein the volatile oil is isododecane.

84. (Canceled).

85. (Previously Presented): The method of claim 74, wherein the silicone-polyamide copolymer is present in an amount ranging from about 0.5% to about 10% by weight relative to the total weight of the composition.

86. (Canceled).

87. (Previously Presented): The method of claim 74, wherein the composition is anhydrous.

88. (Previously Presented): The method of claim 87, wherein the composition further comprises at least one volatile oil.

89. (Canceled).

90. (Previously Presented): The method of claim 87, wherein the film former is selected from the group consisting of polymethylsilsesquioxane, trimethylsiloxysilicate, and mixtures thereof.

91. (Previously Presented): The method of claim 87, wherein the film former is trimethylsiloxysilicate.

92. (Canceled).

93. (Previously Presented): The method of claim 87, wherein the composition comprises at least one volatile oil which is a volatile hydrocarbon oil.

94. (Previously Presented): The method of claim 91, wherein the composition comprises at least one volatile oil which is a volatile hydrocarbon oil.

95. (Canceled).

96. (Previously Presented): The method of claim 87, wherein the silicone-polyamide copolymer is present in an amount ranging from about 0.5% to about 10% by weight relative to the total weight of the composition.

97. (Canceled).

98. (Previously Presented): The method of claim 74, wherein the method comprises applying to the lips a composition comprising at least one silicone-polyamide copolymer, at least one silicone resin film forming agent, and at least one coloring agent.

99. (Previously Presented): The method of claim 98, wherein the composition further comprises at least one volatile oil.

100-101. (Canceled).

102. (Previously Presented): The method of claim 98, wherein the film former is selected from the group consisting of polymethylsilsesquioxane, trimethylsiloxysilicate, and mixtures thereof.

103. (Previously Presented): The method of claim 98, wherein the film former is trimethylsiloxysilicate.

104. (Canceled).

105. (Previously Presented): The method of claim 98, wherein the composition comprises at least one volatile oil which is a volatile hydrocarbon oil.

106. (Canceled).

107. (Previously Presented): The method of claim 105, wherein the volatile oil is isododecane.

108. (Canceled).

109. (Previously Presented): The method of claim 98, wherein the silicone-polyamide copolymer is present in an amount ranging from about 0.5% to about 10% by weight relative to the total weight of the composition.

110. (Canceled).

111. (Previously Presented): The method of claim 98, wherein the composition is anhydrous.

112. (Previously Presented): The method of claim 11, wherein the composition further comprises at least one volatile oil.

113. (Canceled).

114. (Previously Presented): The method of claim 111, wherein the film former is selected from the group consisting of polymethylsilsesquioxane, trimethylsiloxysilicate, and mixtures thereof.

115. (Previously Presented): The method of claim 111, wherein the film former is trimethylsiloxysilicate.

116. (Canceled).

117. (Previously Presented): The method of claim 111, wherein the composition comprises at least one volatile oil which is a volatile hydrocarbon oil.

118. (Previously Presented): The method of claim 115, wherein the composition comprises at least one volatile oil which is a volatile hydrocarbon oil.

119. (Canceled).

120. (Previously Presented): The method of claim 111, wherein the silicone-polyamide copolymer is present in an amount ranging from about 0.5% to about 10% by weight relative to the total weight of the composition.

121. (Canceled).

122. (Previously Presented): The method of claim 74, wherein the method comprises applying to the skin a composition comprising at least one silicone-polyamide copolymer and at least one coloring agent.

123. (Previously Presented): The method of claim 122, wherein the composition further comprises at least one volatile oil.

124-125. (Canceled).

126. (Previously Presented): The method of claim 122, wherein the film former is selected from the group consisting of polymethylsilsesquioxane, trimethylsiloxysilicate, and mixtures thereof.

127. (Previously Presented): The method of claim 122, wherein the film former is trimethylsiloxysilicate.

128. (Canceled).

129. (Previously Presented): The method of claim 122, wherein the composition comprises at least one volatile oil which is a volatile hydrocarbon oil.

130. (Canceled).

131. (Previously Presented): The method of claim 129, wherein the volatile oil is isododecane.

132. (Canceled).

133. (Previously Presented): The method of claim 122, wherein the silicone-polyamide copolymer is present in an amount ranging from about 0.5% to about 10% by weight relative to the total weight of the composition.

134. (Canceled).

135. (Previously Presented): The method of claim 122, wherein the composition is anhydrous.

136. (Previously Presented): The method of claim 135, wherein the composition further comprises at least one volatile oil.

137. (Canceled).

138. (Previously Presented): The method of claim 135, wherein the film former is selected from the group consisting of polymethylsilsesquioxane, trimethylsiloxysilicate, and mixtures thereof.

139. (Previously Presented): The method of claim 135, wherein the film former is trimethylsiloxysilicate.

140. (Canceled).

141. (Previously Presented): The method of claim 135, wherein the composition comprises at least one volatile oil which is a volatile hydrocarbon oil.

142. (Previously Presented): The method of claim 139, wherein the composition comprises at least one volatile oil which is a volatile hydrocarbon oil.

143. (Canceled).

144. (Previously Presented): The method of claim 135, wherein the silicone-polyamide copolymer is present in an amount ranging from about 0.5% to about 10% by weight relative to the total weight of the composition.

145. (Canceled).

146. (Previously Presented): The method of claim 74, wherein the method comprises applying to eyelashes a composition comprising at least one silicone-polyamide copolymer, at least one silicone resin film forming agent, and at least one coloring agent in an amount sufficient to make-up the eyelashes.

147. (Previously Presented): The method of claim 74, wherein the method comprises applying to hair a composition comprising at least one silicone-polyamide copolymer, at least one silicone resin film forming agent, and at least one coloring agent.

148. (Previously Presented): The method of claim 74, wherein the method comprises applying to a nail a composition comprising at least one silicone-polyamide copolymer, at least one silicone resin film forming agent, and at least one coloring agent.

149. (Previously Presented): The method of claim 74, wherein the silicone-polyamide copolymer is a nylon 611/dimethicone copolymer.

150. (Previously Presented): The method of claim 98, wherein the silicone-polyamide copolymer is a nylon 611/dimethicone copolymer.

151. (Previously Presented): The method of claim 122, wherein the silicone-polyamide copolymer is a nylon 611/dimethicone copolymer.

152. (Previously Presented): The method of claim 147, wherein the silicone-polyamide copolymer is a nylon 611/dimethicone copolymer.

153. (Previously Presented): The method of claim 148, wherein the silicone-polyamide copolymer is a nylon 611/dimethicone copolymer.

154. (Previously Presented): The method of claim 79, wherein the trimethylsiloxysilicate is present in an amount ranging from about 0.1% to about 30% by weight relative to the total weight of the composition.

155. (Previously Presented): The method of claim 91, wherein the trimethylsiloxysilicate is present in an amount ranging from about 0.1% to about 30% by weight relative to the total weight of the composition.

156. (Previously Presented): The method of claim 85, wherein the silicone resin film forming agent is present in an amount ranging from about 0.1% to about 30% by weight relative to the total weight of the composition.

157. (Previously Presented): The method of claim 98, wherein the silicone resin film forming agent is present in an amount ranging from about 0.1% to about 30% by weight relative to the total weight of the composition.

158. (Previously Presented): The method of claim 122, wherein the silicone resin film forming agent is present in an amount ranging from about 0.1% to about 30% by weight relative to the total weight of the composition.

159. (Previously Presented): The method of claim 74, wherein the silicone-polyamide copolymer is present in an amount ranging from about 0.1% to about 20% by weight relative to the total weight of the composition.

160. (Previously Presented): The method of claim 87, wherein the silicone-polyamide copolymer is present in an amount ranging from about 0.1% to about 20% by weight relative to the total weight of the composition.

161. (Previously Presented): The method of claim 79, wherein the silicone-polyamide copolymer is a nylon 611/dimethicone copolymer.

162. (Previously Presented): The method of claim 91, wherein the silicone-polyamide copolymer is a nylon 611/dimethicone copolymer.

163. (Previously Presented): The method of claim 103, wherein the silicone-polyamide copolymer is a nylon 611/dimethicone copolymer.

164. (Previously Presented): The method of claim 115, wherein the silicone-polyamide copolymer is a nylon 611/dimethicone copolymer.

165. (Previously Presented): The method of claim 127, wherein the silicone-polyamide copolymer is a nylon 611/dimethicone copolymer.

166. (Previously Presented): The method of claim 139, wherein the silicone-polyamide copolymer is a nylon 611/dimethicone copolymer.

APPENDIX II (EVIDENCE)

Terminal Disclaimer over U.S. Patent Application Serial No. 10/166,762 filed
November 30, 2007.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Veronique FERRARI, et al.

SERIAL NO: 10/733,467

GAU: 1615

FILED: December 12, 2003

EXAMINER: Venkat, Jyothsna A.

FOR: COSMETIC COMPOSITION CONTAINING A POLYORGANOSILOXANE POLYMER

TERMINAL DISCLAIMER

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Now comes the undersigned, Attorney of Record in the present application, who avers as follows:

L'Oreal is the owner of the entire right, title and interest in and to the invention claimed and disclosed in the above-captioned patent application by virtue of assignment, said Assignment having been recorded in the U.S. Patent and Trademark Office at reel no. 015344, frame(s) 0196.

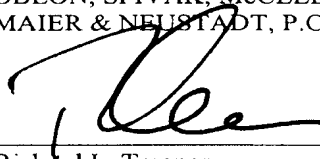
L'Oreal hereby disclaims the terminal part of any patent granted on the above-captioned application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173 as presently shortened by any terminal disclaimer of any patent issuing from application Serial Nos. 11/342,748, 11/254,919, 11/009,088, 10/538,920, 10/538,924, 11/193,444, 10/517,390, 11/024,471, 11/217,293, 10/935,352, 10/166,648, 10/166,762, 10/617,048, 10/166,760, 10/323,649, 10/166,755, 10/160,655, 10/170,566, 10/170,549, 10/320,600, 10/320,599, 60/438,782, 60/438,770, 10/622,689, 60/528,689, 60/528,696, 60/528,700, 10/320,601, 10/166,650, and 60/620,689, and hereby agrees that any patent so granted on said above-captioned application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to any patent issuing from application Serial Nos. 11/342,748, 11/254,919, 11/009,088, 10/538,920, 10/538,924, 11/193,444, 10/517,390, 11/024,471, 11/217,293, 10/935,352, 10/166,648, 10/166,762, 10/617,048, 10/166,760, 10/323,649, 10/166,755, 10/160,655, 10/170,566, 10/170,549, 10/320,600, 10/320,599, 60/438,782, 60/438,770, 10/622,689, 60/528,689, 60/528,696, 60/528,700, 10/320,601, 10/166,650, and 60/620,689, this agreement to run with any patent granted on the above-captioned application and to be binding upon the grantee, its successors or assigns.

L'Oreal does not disclaim any terminal part of any patent granted on the above-captioned application that would extend to the full statutory term as defined in 35 U.S.C. 154 and 173 as presently shortened by any terminal disclaimer of any patent issuing from application Serial Nos. 11/342,748, 11/254,919, 11/009,088, 10/538,920, 10/538,924, 11/193,444, 10/517,390, 11/024,471, 11/217,293, 10/935,352, 10/166,648, 10/166,762, 10/617,048, 10/166,760, 10/323,649, 10/166,755, 10/160,655, 10/170,566, 10/170,549, 10/320,600, 10/320,599, 60/438,782, 60/438,770, 10/622,689, 60/528,689, 60/528,696, 60/528,700, 10/320,601, 10/166,650, and 60/620,689 in the event that any said issued patent later: expires for failure to pay a

maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

Respectfully Submitted,

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APPENDIX III (RELATED PROCEEDINGS)

None.